UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,779	03/23/2004	John Gerard Speare	MS#304047.01 (5226)	2381

38779 7590 10/23/2006		EXAMINER
SENNIGER POWERS (MSFT)		VO, TED T
ONE METROPOLITAN SQUARE, 16TH FLOOR		

ART UNIT	PAPER NUMBER
2191	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 July 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed on 07/21/2006.

This action is non-final.   Applicant's arguments have been considered but are moot in view of the

new ground(s) of rejection.

Claims 1-27 are pending in the application.

Response to Amendment

2.   Examiner directs Applicants to review the content of the amended Claim 1 filed on 08/29/05,

"*determining whether the electronic document <u>has exceeded the rights management</u>*

<u>protections</u> is subject to the persisted policy scheme; and"

and the current amended claim 1 (filed on 7/21/06),

"*determining whether the <u>content of the</u> electronic document has exceeded the rights*

management protections has exceeded the rights management protections is subject to <u>defined</u>

<u>by</u> the persisted policy scheme; and"

The amendment is inconsistent and fails to comply with 37 CFR 1.121. Accordingly, there is no

limitation, "*is subject to the persisted policy scheme*" in the claim.

The problem happens the same to Claims 5-6, 10-11, 15.

The amendment to claims 16, 19 is inconsistent to the limitation, "*is unavailable if*", within

"*configuring the updating process...*", filed on 08/29/05.

The amendment must be pursuant to 37 CFR 1.121. Correction is requested.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-4, 5, 6-9, 10, 11-14, 15, 16-18, 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 5, 6-9, 10, 11-14, 15, 16-18, 19: Claims 1, 5-6, 10-11, 15-16, 19 have the amendment which fails to comply with 37 CFR 1.121 as indicated above. It is unclear what the limitation in the claims.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   The claims 5, 10, 15, 19, 23, 27 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 5, 10, 15, 19, 23, 27: The Claims recite "A computer-readable medium containing instruction". In the specification, this medium include a non statutory subject mater:

Communication channels 112 are examples of communications media. Communications media typically embody computer-readable instructions, data structures, program modules, or other data in a modulated data signal such as a carrier wave or other transport mechanism and include any information-delivery media. The term "modulated data signal" means a signal that has one or more of its characteristics set or changed in such a manner as to encode information in the signal. By way of example, and not limitation, communications media include wired media, such as wired networks and direct-wired connections, **and wireless media such as acoustic, radio, infrared, and other wireless media**. The term computer-readable media as used herein includes both storage media and communications media. The computing device 100 may also have input components 114 such as a keyboard, mouse, pen, a voice-input component, and a touch-input device. Output components 116 include screen displays, speakers, printers, and

rendering modules (often called "adapters") for driving them. The computing device 100 has a power supply 118. All these components are well known in the art and need not be discussed at length here

The term "media" that includes in the specification causes the claims fail to be statutory because it is not concrete and tangible subject mater. The claims thus claim an abstract idea and fail to be statutory under 35 U.S.C. 101.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of application amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8.   Claim 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by SealedMedia, "Software Developer's Kit", 2002.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Regarding claimed limitation:

A computerized method for updating content in an electronic document, wherein the updating relies on the existence of a persisted policy scheme, the computerized method comprising:

accepting the electronic document;

identifying one or more rights management protections associated with <u>content of</u> electronic

document (See Figure 2, "content sets"), said rights management protections being defined by persisted

policy scheme;

pre-licensing the accepted electronic document by obtaining a use license on behalf of a user,

said use license being defined by the persisted policy scheme (see p. 5: Overview (and the Figure 1)

provides means for obtaining a use license on behalf of a user);

determining whether the <u>content of the</u> electronic document has exceeded the rights

management protections [is subject to <u>**defined by**</u> the persisted policy scheme]; and

If the electronic document has exceeded the rights management protections, replace a portion of

the content of the electronic document with an indicating piece of data such that the content of the

electronic document is modified (See p. 9)<u>;and permitting use of the modified content of the electronic</u>

<u>document in accordance with the obtained use license.</u>" (see p. 8-9, "publishers can configure any

number of differenct licenses,,,, New sealed content filed can be added..., etc.)

Note: the limitation within the squared brackets is unknown under 37 CFR 1.121.

Figure 2 (p. 8) of SealedMedia shows **content sets**/categories/electronic documents which are

available to a user (valid license) during the time of license under rights management protections defined

by a persisted policy scheme. The user is connected to available documents, e.g. via URLs. If time of

license expired, a default URL (See p. 10, second square) would be replaced, or the user sees the item

"Not specified" or the item listed under the article name (See p. 8. Figure 2; see p.9-10, Configuring

content sets; see p. 11-12, Configuring license templates; see p. 14-15: Validity and expiry). In a similar

manner, see p.10, see "The Metadata ...", it describes when a license is expired, i.e. invalid license, the

Unsealer displays a status describing why the content cannot be rendered, with a link to the Default URL

> The metadata is used by the Unsealer to identify the content and to request appropriate licenses.
> If no valid license is available, <u>the Unsealer displays a status page describing why the content</u>
> <u>cannot be rendered, with a link to the Default URL. It is also possible to instruct the Unsealer to</u>
> <u>render the Default URL</u> within the browser directly, giving you a more close control over the user
> experience. Once <u>a license has been obtained</u>, the metadata is also used to determine ongoing
> license validity, e.g. license expiration may be relative to the publication time sealed in with the
> content.

And, Figure 1 shows in the page provides obtaining a use license on behalf of a user.

As per Claim 2: SealedMedia disclose the claimed limitation because it includes email scheme (See p.31:

Email gateway).

As per Claim 3: SealedMedia disclose the claimed limitation because it discusses time-based licensing

manner (See p.12).

As per Claim 4: SealedMedia disclose the claimed limitation because the appearance of unavailable

contents/documents is in ad-hoc manner (e.g. see Figure 2).

As per Claims 5, 10, 15, 19, 23, 27: The Claims have the same functionality as recited in Claim 1. The

Claims are rejected in the same reason set forth in Claim 1.

As per Claims 6-9: The Claims have the same functionality as recited in Claims 1-4. The Claims are

rejected in the same reasons set forth in Claims 1-4.

As per Claims 11-14: The Claims have the same functionality as recited in Claims 1-4. The Claims are

rejected in the same reasons set forth in Claims 1-4.

As per Claims 16-18: The Claims have the same functionality as recited in Claims 1, 3-4. The Claims are

rejected in the same reasons set forth in Claims 1, 3-4.

As per Claims 20-22: The Claims have the same functionality as recited in Claims 1, 3-4. The Claims are

rejected in the same reasons set forth in Claims 1, 3-4.

As per Claims 24-26: The Claims have the same functionality as recited in Claims 1, 3-4. The Claims are

rejected in the same reasons set forth in Claims 1, 3-4.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be

reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV
October 13, 2005

TED VO
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100